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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,755	08/30/2001	Kulvir Singh Bhogal	AUS920010510US1	9948

35525 7590 07/17/2006

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EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/942,755		BHOGAL ET AL.	
	Examiner		Art Unit	
	Peter Pollorak		2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 11-13, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 11-13 and 19-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment, and remarks therein, received on 4/25/06 have been entered and carefully considered.
2. The Amendment introduces new limitations into the originally sole independent claim 1, 11 and 19, amended claims 3, 5 and 13, and cancelled claims 4, 6-10 and 14-18.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

4. The amendments addressed the 35 USC § 112 rejections cited in the previous Office Action and as a result the previous rejections have been withdrawn.
5. Applicant argues that the art of record does not disclose that "the received personal identification information is automatically stored, during the phone call, in either a server or memory on the telephone based on a user preference". The arguments are directed towards the limitations that in the previous set of claims were present in claim 4 and were rejected with the Official Notice.
6. Applicant arguments have been carefully considered but were not found persuasive.

Wu's invention is directed towards a phone call communication. Also, the examiner points out that the idea of storing information either locally (e.g. on the telephone) or remotely (e.g. a server) is well known in the art of computing.

Similarly, configuring a system to complete tasks (such as storing information) automatically based on a user preference is one of the primary goal of computing.

As a result, automatically storing "the personal identification information", in one of a

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server and memory on the telephone based on a user preference without subsequent action by a user (e.g. deleting the information) could not be considered novel. Furthermore, as per additional argument that modification of Wu's invention in order to accommodate storing information given benefit of later retrieval would be "improper hindsight", the examiner points out that by definition "storing" refers to retrieving the stored thing later (e.g. Webster Dictionary: "store: something that is stored or kept for future use"). As a result, automatically storing the personal identification information, in one of a server and memory on the telephone based on a user preference without subsequent action by a user given the benefit of accessibility to the information at later time would have been obvious to one of ordinary skill in the art at the time of applicant's invention given the benefit of future access to the received information.

In order to further emphasize the concept of automatic storing of information the examiner points to U.S. Patent 5467383 issued in 1995 that is directed towards a phone apparatus. In the prior art discussion Urasaka explicitly discusses storing received information that based on user preferences are automatically stored without subsequent action by a user (col. 1 lines 29-41).

7. Claims 1, 11 and 19 incorporate the limitations of previously presented claim 4 and as a result for purposes of consistency and in order not to introduce new grounds of rejection claims 1, 11 and 19 similar to previously rejected claim 4 are rejected over Wu in view of Official Notice.

8. Claims 1-3, 5, 11-13 and 19-20 have been examined.

Claim Rejections - 35 USC § 112

9. Claims 3 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 3 and 13 recites: "the personal identification information is stored on another server". Although the limitation is not clear the examiner guesses that the limitation attempts to differentiate between a server on which the information is stored and the server from which the information is retrieved. However, there is no support for such a limitation in the specification.

10. Claims 3 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. It is not clear what the phrase: "stored on another server and retrieved from the another server" means. For purposes of further examination the phrase is treated as though indicating that the sender retrieves the personal identification information from a server that could be different from the server utilized by a recipient of the information.

Claim Rejections - 35 USC § 103

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11. Claims 1-3, 5 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S. Patent No. 6744874) in view of Official Notice.

Wu invention is directed towards the separation of the user phone number from the physical phone number (col. 2 lines 63-65) wherein an individual move can update the physical phone number.

12. As per claims 1-2 and 5 Wu teaches message in message communication mode wherein during the communication in one type of message, another type of message can be transmitted and displayed properly (e.g. col. 4 lines 58-61).

Specifically Wu discloses that during the communication in one type of message, another type of message is transmitted and displayed properly. The second message can be transmitted over the same physical connection. For example, during a normal telephone conversation, one provides her telephone number and address in the text form and the other party sees the information on a display device, thus increasing the efficiency and avoiding possible errors in recording such information. The text information can be provided in a digital form by the well-known Frequency-shift Keying (FSK) or Phaseshift Keying (PSK) methods. The text can be displayed just like the Caller ID with Name is displayed in the prior art method. In this case, additional line seize is not necessary for the transmission of the text message since the same physical connection can be used for both messages. The display device detects the second message and displays it accordingly. This can occur simultaneously with the voice conversation. Examples of this type of message-in-

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message mode includes short text messages during a telephone conversation (col. 13 lines 22-47).

Wu provides an example where a customer initiates a phone call to a merchant to place an order by telephone. Upon the merchant receiving the phone call the customer provides his name and address in text form through the message-in-message method during the telephone conversation and the merchant will receive the message (col. 15 lines 50-62).

This reads on receiving, by the telephone an incoming phone call from a communication link and during the phone call, receiving, by the telephone, a communication transmission from the communication link, wherein the communication transmission contains textual personal identification information about a party initiating the phone call, and wherein the personal identification information is independent of an identity of a device used to initiate the phone call.

13. Wu does not explicitly disclose that the personal identification information is automatically stored, during the phone call, in one of a server and memory on the telephone based on a user preference without subsequent action by a user of the telephone after receiving the incoming call.

Official Notice is taken that it is old and well-known practice to automatically store received data, such as personal identification information, e.g. a phone number, in one of a server and memory on the telephone base on a user preference without subsequent action by a user. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to automatically store, during the phone

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call, in one of a server and memory on the telephone based on a user preference without subsequent action by a user of the telephone after receiving the incoming call given the benefit of accessibility to the information at later time.

14. Claims 11-12 are substantially equivalent to claims 1-2 and 5; therefore claims 11-12 are similarly rejected.

15. As per claims 3 and 13 Official Notice is taken that it is old and well-known practice to store and retrieve data on/from a server, and provide separate servers for a sender and a recipient (e.g. corporate email servers, web mail servers, e.g. yahoo, hotmail etc.). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to store data on/from a server and not to limit the communication sender and a recipient to storing the information on the same server given the benefit of security, flexibility and reliability (e.g. data back up) while keeping the size of the information on servers manageable (servers have finite amount of space and information size influences the time of retrieval of the particular type of information).

16. Claim 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S. Patent No. 6744874) in view of Engelke (U.S. Patent No. 5974116).

Wu teaches the two type of occurring during a phone call communication as discussed above.

17. As per claim 19 Wu does not teach that the first communication transmission's frequency range is different from the second frequency range of the second communication transmission.

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Enelke teach two frequency ranges for two communication transmissions (col. 4 lines 50-64).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use different range for the two communication transmission as taught by Enelke. One of ordinary skill in the art would have been motivated to perform such a modification so that the electronics would not confuse any elements of the spoken word with digital communications.

18. As per claim 20 Enelke teach using frequencies between 2800 and 3500 Hertz and suggest allocating upper band to the text (col. 4 lines 50-64).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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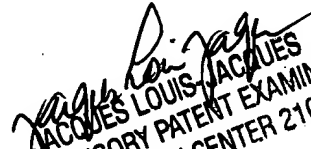
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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